Attorney's Docket: 2003DE411
Serial No.: 10/783,188
Art Unit 1621
Response to First Office Action mailed 08/09/2006

REMARKS

The Office Action mailed August 9, 2006 has been carefully considered together with each of the references cited therein. The amendments and remarks presented herein are believed to be fully responsive to the Office Action. Reconsideration of the present Application in view of the following remarks is respectfully requested.

Applicant has amended the Specification to correct a typographical error which was not earlier noticed. In paragraph [00049], the reference to WO 97/6505 was replaced with the proper reference to WO 98/23843. It is believed that this amendment does not add new matter to the Specification.

Claim 10 was rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claim 10 recites that D is the fragment defined by formula (3), and in Applicant's Specification at paragraph [00035] it is disclosed that the bonding of formula (3) is through a valence of an alkyl or alkenyl radical at any point of R^7 or R^{12}. Thus there is no need to amend claim 10 for the reason that the structural element of formula (3) is incorporated into formula (1) as a whole. Therefore, the rejection of claim 10 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention should be withdrawn.

Claims 1, 3-6, and 8-10 were rejected under 35 U.S.C. §103(a) as being unpatentable over Klomp et al. (USP 5648575) in view of Klug et al. (WO 98/23843). The rejection of claim 1 under 35 U.S.C. §103(a) as being unpatentable over Klomp et al. (USP 5648575) in view of Klug et al. (WO 98/23843) should be withdrawn for the reason that Klomp et al. is a very broad disclosure relating to gas hydrate inhibitors having the structure shown below:

wherein

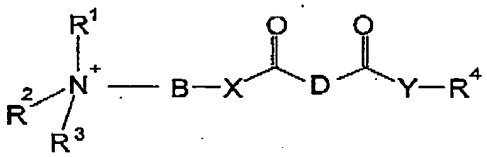
R_1 and R_2 are independently chosen from the group consisting of normal and branched alkyls having at least 4 carbon atoms,

R_3 is an organic moiety containing a chain of at least 4 atoms,

X is selected from the group consisting of S, N—R_4, and P—R_4,

R_4 is selected from the group consisting of hydrogen and an organic substituent; and

Klomp et al. disclose thousands of possible combinations, but do not provide any motivation for choosing the compound of Applicant's claim 1, containing a succinic acid derivative having a structure of formula (1)



(1)

with substituents as defined in claim 1, for use as a gas hydrate inhibitor. Klug et al. relates only to polymers comprising structural units of succinic acid derivatives. The Examiner alleges that the teaching of Klug et al. is that compounds having a dicarboxylated moiety possess gas hydrate inhibiting activity. This is incorrect. It is very clear from the disclosure of Klug et al., that Klug et al. relates only to polymers having succinic acid moeites, and that these polymers have gas hydrate inhibiting activity. To assume that a physical property of a polymer such as gas hydrate inhibiting activity is predictable by virtue of the inclusion of a single particular monomer is not based on fact. It is common general knowledge that the behavior and the properties of polymers are different from the properties of the monomers which are used to form the polymers. Simple examples are monomers such as ethylene, vinyl acetate, or styrene which as polymers do not resemble their monomers in any manner. Thus, no one skilled in the art would be motivated to combine the Klomp et al. patent with the Klug et al. publication to arrive at a succinic

acid derivative polymer, and further arrive at such a polymer containing ammonium groups, without using Applicant's specification as a guide. Obviousness is not determined by the application of hindsight, or retrospect, with the knowledge of the Applicant's discovery. Rather it is determined as of the time of the invention, based solely on the knowledge disclosed by the prior art as a whole. A prima facie case of obviousness is not made out where there is a lack of motivation to use some prior art in Applicant's invention. Consequently, one skilled in this art, working at the time Applicant's invention was made on the problem of inhibiting gas hydrates would not have been motivated or guided by the prior art to arrive at Applicant's invention. Furthermore, obvious to try is not the standard of 35 U.S.C. 103. A rejection based on Section 103 clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, all facts must be considered. The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis. Therefore, the rejection of claim 1 under 35 U.S.C. §103(a) as being unpatentable over Klomp et al. (USP 5648575) in view of Klug et al. (WO 98/23843) should be withdrawn for the reason that the Examiner has failed make a prima facie case of obviousness because Klomp et al. do not provide any motivation for choosing the compound of Applicant's claim 1, containing a succinic acid derivative, and Klug et al. relates only to polymers comprising structural units of succinic acid derivatives, and there is no teaching or suggestion to make the proposed combination.

The rejection 3-6, and 8-10 were rejected under 35 U.S.C. §103(a) as being unpatentable over Klomp et al. (USP 5648575) in view of Klug et al. (WO 98/23843) should be withdrawn for the reasons given in support of claim 1 from which they depend.

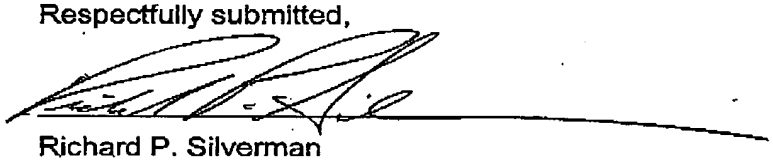
Claims 1, 3-7 and 9 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-7 of copending Application No. 10/783,153. Applicant has attached a Terminal Disclaimer in compliance with 37 CFR 1.321(c) signed by the undersigned. Applicant

has herewith provided a Terminal Disclaimer which disclaims the terminal portion of the statutory term of any patent granted on the instant invention which would extend beyond the expiration date of the full statutory term of any patent issuing from Application No. 10/783,153 which is commonly owned and the extent of which is the whole of this invention. Therefore, the rejection of claims 1, 3-7 and 9 under the judicially created doctrine of obviousness type double patenting as being unpatentable over claim 1-7 of Application No. 10/783,153 should be withdrawn in view of the attached Terminal Disclaimer.

It is respectfully submitted that, in view of the above remarks the rejections under the judicially created doctrine of obviousness-type double patenting, and the rejections under 35 U.S.C. 112 and 103, should be withdrawn and that this application is in a condition for an allowance of all pending claims. Accordingly, favorable reconsideration and an allowance of all pending claims are courteously solicited.

An early and favorable action is courteously solicited.

Respectfully submitted,



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Attachment:
Terminal Disclaimer